

## **REMARKS**

### **Amendments to the Claims:**

Claims 78-80 have been re-written in independent format including all the limitations of base claim 1. Dependencies to claims 78 or 79 have also been added in claims 2-14, 16-19, 22-23 and 89-90 in order to maintain the scope of protection. (Note that the dependency in claims 78-79 before their amendment should have been to claims 1-14 and 16-19 instead of claims 1-18 since claim 15 was canceled in the previous response). New dependencies to claims 78 or 79 have also been added in claims 41-42.

Claim 11 has been re-written to depend directly from independent claim 1 (or 78 or 79) instead of dependent claim 10.

Claim 19 has been amended to depend from claim 1, 78 or 79 in order to avoid improper multiple dependencies (i.e., from multiple dependent claims 3-14, 16, 22-23 and 89-90).

Claim 41 has been amended to depend from claim 1, 78 or 79 in order to avoid improper multiple dependencies (i.e., from multiple dependent claims 2-14, 16-18, 22-23 and 89-90).

Claim 45 has been amended to depend from claim 42 only in order to avoid an improper multiple dependency.

Claim 84 has been re-written in independent format incorporating all the limitations of base claims 81-83.

Claims 85-88 have been re-written in independent format incorporating all the limitations of base claim 84.

### **Rejection under 35 U.S.C. § 112, second paragraph:**

The only rejection that remains in the present application is for lack of definiteness under 35 U.S.C. § 112, second paragraph. The rejection includes six sub-parts that are addressed in turn below.

#### *(i) Heteroaliphatic*

The Examiner states that the definition of a “heteroaliphatic” moiety is “so open-ended that the metes and bounds could not be ascertained” (see claim 1 and amended claims 78-80 and 84-88). Applicant respectfully disagrees.

The purpose of the claim definiteness requirement is to (a) ensure that the scope of the claims is clear so that the public is informed of the boundaries of what constitutes infringement of the patent and (b) provide a clear measure of what Applicant regards as the invention so that it can be determined whether the claimed invention meets all the criteria for patentability. MPEP §2173. No more is required. In particular, if the scope of the subject matter embraced by the claims is clear, and if Applicant has not otherwise indicated that they intended the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. §112, second paragraph. MPEP §2173.04.

A “heteroaliphatic moiety” is explicitly defined in the claims as a “2-8-membered non-cyclic or 3-10-membered cyclic aliphatic moiety which contains one or more oxygen, sulfur, nitrogen, phosphorous or silicon atoms”. An “aliphatic moiety” is also explicitly defined in the claims as a “saturated or unsaturated, branched or unbranched, cyclic or polycyclic, aliphatic hydrocarbon containing 1-8 contiguous aliphatic carbon atoms”. These definitions are closed – they are in no way “open-ended” as the Examiner suggests.

These definitions are also explicitly supported by the specification (e.g., see page 30, line 34 – page 32, line 4). There is no indication that Applicant intended definitions of narrower scope. There is also no doubt that those having ordinary skill in the art can tell whether a particular moiety is a “heteroaliphatic moiety” as explicitly defined in the claims. Accordingly, there is no reason to believe that a person of ordinary skill in the art would not be able to determine whether a particular compound lies within or outside the scope of claims that include the term. No more is required to satisfy the claim definiteness requirement – the rejection should therefore be removed.

*(ii) Heteroaryl*

The Examiner states that the upper limit of allowable heteroatoms in a “heteroaryl” moiety needs to be specified (see claim 1 and amended claims 78-80 and 84-88). Applicant respectfully disagrees.

The purpose of the claim definiteness requirement is discussed *supra*. As noted, if the scope of the subject matter embraced by the claims is clear, and if Applicant has not otherwise indicated that they intended the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. §112, second paragraph. MPEP §2173.04.

The term “heteroaryl moiety” is explicitly defined in the claims as a “5-6-membered monocyclic or 9-14-membered polycyclic unsaturated moiety which contains one or more oxygen, sulfur or nitrogen atoms”. This definition is closed.

The definition is also explicitly supported by the specification (e.g., see page 32, line 1-31 especially lines 1-4, 5-7 and 8-10). There is no indication that Applicant intended a definition of narrower scope. There is also no doubt that those having ordinary skill in the art can tell whether a particular moiety is a “heteroaryl moiety” as explicitly defined in the claims. Accordingly, there is no reason to believe that a person of ordinary skill in the art would not be able to determine whether a particular compound lies within or outside the scope of claims that include the term. No more is required to satisfy the claim definiteness requirement – the rejection should therefore be removed.

*(iii) Claim 11*

The Examiner states that claim 11 improperly depends from claim 10 since a “hydroxyalkyl group is not permitted in claim 10”. Applicant respectfully disagrees with this rejection; however, for the sole purpose of expediting prosecution of this case towards allowance, claim 11 has been re-written to depend directly from claim 1 (or 78 or 79). Reconsideration and withdrawal of the rejection is therefore respectfully requested.

*(iv) Claim 41*

The Examiner suggests that the term “pharmaceutical” be inserted before “composition” in claim 41. Applicant would like to thank the Examiner for the suggestion but prefers to leave claim 41 unamended. As described in the specification, the compounds and compositions of the present invention find uses in both pharmaceutical and non-pharmaceutical contexts. Limitation of the preamble to “pharmaceutical” compositions is therefore neither necessary nor appropriate.

*(v) Claims 78-80*

The Examiner states that there is insufficient antecedent basis in the base claims for the recitation of substituents in dependent claims 78-80. Applicant respectfully disagrees with this rejection; however, for the sole purpose of expediting prosecution of this case towards allowance, claims 78-80 have been re-written in independent format incorporating all the

limitations of base claim 1. Reconsideration and withdrawal of the rejection is therefore respectfully requested.

*(vi) Claims 84-88*


The Examiner states that it is improper for claims 84-88 to add additional limitations to base claims 81-83 since these claims are species claims. Applicant respectfully disagrees with this rejection; however, for the sole purpose of expediting prosecution of this case towards allowance, claims 84-88 have been re-written in independent format. Reconsideration and withdrawal of the rejection is therefore respectfully requested.

**Conclusion:**

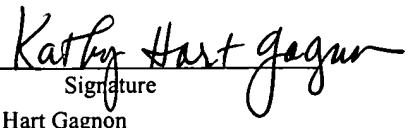
For the reasons presented above, it is submitted that the pending claims are allowable. If the Examiner feels that a telephone interview would expedite the prosecution of this case towards allowance he is invited to contact the undersigned at 617-248-4793. In addition, please charge any fees that may be required, or credit any overpayment, to our Deposit Account No. 03-1721.

Respectfully submitted,

Dated: August 3, 2004

  
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Limited Recognition Under 37 CFR §10.9(b)

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